

REMARKS/ARGUMENTS

Claims 1-5, 10, 12-15, 17-20 and 22-33 are currently pending in the application. The examiner determined that claims 23-33 are subject to a restriction requirement in the Office Action mailed October 30, 2006 (hereinafter referred to as "Office Action"). It is believed that no fees are due at this time. In view of the following remarks and amendments, applicant respectfully requests a timely Notice of Allowance be issued in this case.

Traverse of Restriction Requirement

The examiner determined that claims 23-33 are subject to a restriction requirement based on the following inventions:

- Group I: Claims 23-28, drawn to an apparatus for managing infrastructure, classified in class 707, subclasses 3 and 200;
- Group II: Claims 29-31, drawn to a method for creating an asset management database, classified in class 707, subclass 102; and
- Group III: Claims 32-33, drawn to a method for creating an asset management system, classified in class 705, subclass 8, and class 707, subclass 104.1.

The examiner stated that the application contains claims directed to the above patentably distinct species. Applicant respectfully requests reconsideration and withdrawal of the restriction requirement.

Every requirement to restrict has two aspects, (1) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct, and (2) the reasons for insisting upon restriction there between. MPEP § 808. With regard to the first aspect, applicant respectfully submits that the examiner merely states a conclusion that the claims directed to patentably distinct species without stating specific reasons for such a conclusion. Accordingly, applicant respectfully submits that the Office Action fails to satisfy the first aspect. As a result, applicant respectfully requests withdrawal of the restriction requirement.

With regard to the second aspect, the reasons under MPEP § 808 given by the Examiner for insisting upon exercising his authority under 35 U.S.C. § 121 to require restriction must be reasons approved by the Commissioner. The reasons approved by the Commissioner are set out in MPEP § 803: (1) the inventions must be independent (see MPEP §§ 802.01, 806.04, 808.01) or distinct as claimed (see MPEP §§ 806.05 806.05(i); and (2) there must be a serious burden on the examiner if restriction is not required (see MPEP §§ 803.02, 806.04(a) (j), 808.01(a) and 808.02). Examiner must provide reasons and/or examples to support conclusions. MPEP § 803.

For purposes of the initial requirement, a serious burden on the examiner may be shown, *prima facie*, if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant. MPEP § 803. Applicant respectfully asserts that the examiner has failed to make a *prima facie* case that

restriction is required. The Office Action states that the inventions are related, Groups I, II and III are all classified in class 707. Moreover, the Office Action merely provides a conclusion that the inventions are either independent or distinct. Applicant respectfully submits that these explanations are insufficient. Furthermore, the Office Action failed to establish that a serious burden would be imposed on the examiner if restriction were not required. In particular, applicant respectfully submits that searching one class (two classes with respect to Group III), each having different subclasses is not a serious burden. Therefore, applicant respectfully asserts that the prima facie requirements of MPEP § 803 have not been met. Accordingly, applicant respectfully urges that the requirement for restriction/election is improper. Applicant respectfully requests reconsideration and withdrawal of the restriction/election requirement.

Provisional Election of Claims

In accordance with 37 C.F.R. § 1.143, applicant provisionally elects, with traverse, Group III containing claims 32-33 in the event that the restriction requirement in the Office Action is not withdrawn. As a result and as reflected in the provisional Listing of Claims, claims 1-5, 10, 12-15, 17-20, 22 and 32-33 would be pending and claims 23-31 would be withdrawn with traverse. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141.

Conclusion

For the reasons set forth above, applicant respectfully requests reconsideration by the examiner and withdrawal of the restriction requirement. Applicant submits that claims 1-5, 10, 12-15, 17-20, 22 and 32-33 are fully patentable. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the examiner has any questions or comments, or if further clarification is required, it is requested that the examiner contact the undersigned at the telephone number listed below.

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Respectfully submitted,

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